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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/874,350

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Beverly S. Packard

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EXAMINER

KAM, CHIH MIN

ART UNIT

PAPER NUMBER

1656

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/874,350

Applicant(s)

PACKARD ET AL.

Examiner

Chih-Min Kam

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7, 9-12, 14-16, 21-31, 33, 34 and 36-38 is/are allowed.
- 6) ☒ Claim(s) 13 and 32 is/are rejected.
- 7) ☒ Claim(s) 17-20 and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of the Claims***

1. Claims 1-7 and 9-38 are pending.

Applicants' amendment and a terminal disclaimer filed on October 23, 2006 are acknowledged. Applicants' response has been fully considered. Claim 15 has been amended, it appears that claims 1 and 21 have also been amended, although the status of the claims does not indicate as amended. Thus, claims 1-7 and 9-38 are examined.

### ***Sequence Listing***

2. A paper copy and a computer readable form (CRF) of a substitute Sequence Listing filed October 23, 2006 are acknowledged, and CRF has been entered.

### **Withdrawn Informalities**

3. The previous objection to the specification regarding "J" in Table 4 is withdrawn in view of applicant's amendment to the specification, and applicant's response at page 11 of the amendment filed October 23, 2006.

### **Withdrawn Claim Rejections -Obviousness Type Double Patenting**

4. The previous rejection of claims 1-7 and 9-38, under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5-13 and 27 of U. S. Patent 6,037,137, is withdrawn in view of applicants' submission of a terminal disclaimer, and applicants' response in the amendment filed October 23, 2006.

**Withdrawn Claim Rejections - 35 USC § 112**

5. The previous rejection of claims 4-7, 16-20 and 21-38 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendment to the claim, and applicant's response at page 12 of the amendment filed October 23, 2006.

***Informalities***

The disclosure is objected to because of the following informalities:

6. A sequence search indicates that SEQ ID NO:218 (14 amino acids) has the same sequence as SEQ ID NO: 55, 56 or 57, however, SEQ ID NO:57 in Table 4, page 27 has KDBGYVHDAPVGP~~KG~~GY (16 amino acids); and SEQ ID NO:219 (16 amino acids) has the same sequence as SEQ ID NO: 58, 59 or 60, however, SEQ ID NO:60 in Table 4, page 27 has KDBJGYVHDAPVGP~~KG~~GY (17 amino acids). Thus, the sequences of SEQ ID NO:57 and 60 in the sequence Listing are not consistent with the sequences in Table 4. Appropriate clarification is required.

***Claim Objections***

7. Claims 13, 17-20, 32 and 35 are objected to because there are two commas “ , , ” in the claims. Claims 17 and 35 recite 9-fluorrenacetyl group as one of the hydrophobic groups since the dependent claim cites the term “Fa”, it is more clearly indicated if claims 17 and 35 recite the term “ 9-fluorrenacetyl group (Fa)”.

***New Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 13 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and 32 are indefinite because of the use of the term “9-(2,5-dicarboxyphenyl)-3,6-bis(dimethylamino)xanthylumhalide or other anion (TMR), 9-(2,6-dicarboxyphenyl)-3,6-bis(dimethylamino)xanthylumhalide or other anion (TMR), ..... 9-(2,5-dicarboxyphenyl)-3,6-bis-(dimethylamino)xanthylum chloride (5-TMR), 9-(2,6-dicarboxyphenyl)-3,6-bis-(dimethylamino)xanthylum chloride (6-TMR).....”, it is not clear whether 9-(2,5-dicarboxyphenyl)-3,6-bis(dimethylamino)xanthylumhalide is the same as 9-(2,6-dicarboxyphenyl)-3,6-bis(dimethylamino)xanthylumhalide since these two compounds are labeled as TMR, which is not consistent with the abbreviation of 5-TMR and 6-TMR.

### *Conclusion*

9. Claims 13 and 32 are rejected; and claims 17-20 and 35 are objected to. It appears that claims 1-7, 9-12, 14-16, 21-31, 33, 34 and 36-38 are free of art and allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Bragdon can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.  
Primary Patent Examiner



CHIH-MIN KAM  
PRIMARY EXAMINER

CMK

January 16, 2007